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APPENDIX A

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 00-10510

D.C. Docket No. 97-03924-CV-JAL

JERRY GREENBERG,
IDAZ GREENBERG,

Plaintiffs-Appellants,

versus

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia Corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, MINDSCAPE, INC.,
a California corporation,

Defendants-Appellees.

Appeal from the United States District Court
for the Southern District of Florida

(March 22, 2001)

Before ANDERSON, Chief Judge, and TJOFLAT and BIRCH, Circuit Judges.

BIRCH, Circuit Judge:

This appeal requires us, as a matter of first impression in this circuit, to construe the extent of the privilege afforded to the owner of a copyright in a collective work to reproduce and distribute the individual contributions to the collective work "as part of that particular collective work, any revision of that

collective work, and any later collective work in the same series" under 17 U.S.C. § 201(c).[1] In this copyright infringement case, the district court granted the defendants' motion for summary judgment, holding that the allegedly infringing work was a revision of a prior collective work that fell within the defendants' privilege under § 201(c). Because we find that the defendants' product is not merely a revision of the prior collective work but instead constitutes a new collective work that lies beyond the scope of § 201(c), we **REVERSE**.

I. BACKGROUND

The National Geographic Society ("Society") purports to be the world's largest nonprofit scientific and educational organization at approximately 9.5 million members, and is responsible for the publication of National Geographic Magazine ("Magazine"). Through National Geographic Enterprises, a wholly owned, for-profit subsidiary, the Society also produces television programs and computer software, along with other educational products. In order to acquire photographs for the Magazine and its other publications, the Society hires freelance photographers on an independent-contractor basis to complete specific assignments.

Jerry Greenberg is a photographer who completed four photographic assignments for the Society over the course of 30 years. Photographs from the first three assignments were published in the January 1962, February 1968, and May 1971 issues of the Magazine, respectively. The terms of Greenberg's employment for these assignments were set out in a series of relatively informal letters. Greenberg received compensation consisting of a daily fee, a fee based on the number of photographs published, and payment of expenses, and in return the Society acquired all rights in any photograph taken on the

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[1] Hereafter, all references to statutory sections ("§") will be to Title 17 of the United States Code, unless indicated otherwise.

jobs that was ultimately selected for publication in the Magazine. In 1985, at Greenberg's request, the Society reassigned its copyrights in the pictures from these three jobs back to Greenberg. Greenberg's fourth hire for the Society appeared in the July 1990 issue of the Magazine, but the agreement for this job was more detailed than its predecessors. The principle terms of the fourth agreement were similar to those of the first three; however, in this agreement it was explicitly provided that all rights that the Society acquired in the photographs from the job would be returned to Greenberg 60 days after the pictures were published in the Magazine.

In 1996, the Society, in collaboration with Mindscape, Inc., began the development of a product called "The Complete National Geographic" ("CNG"), which is a 30 CD-ROM library that collects every[2] issue of the Magazine from 1888 to 1996 in digital format. There are three components of the CNG that are relevant to this appeal: (1) the moving covers sequence ("Sequence"); (2) the digitally reproduced issues of the Magazine themselves ("Replica"); and (3) the computer program that serves as the storage repository and retrieval system for the images ("Program").

The Sequence is an animated clip that plays automatically when any disc from the CNG library is activated. The clip begins with the image of an actual cover of a past issue of the Magazine. This image, through the use of computer animation, overlappingly fades ("morphs") into the image of another cover, pauses on that cover for approximately one second, and then morphs into another cover image, and so on, until 10 different covers have been displayed. One of the cover images used in the moving covers sequence is a picture of a diver that

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[2] The Society publishes multiple regional and international editions of each issue of the Magazine. These various editions differ from one another in the language in which they are written and the advertisements that are printed. The CNG includes only one representative edition of each issue.

was taken by Greenberg in 1961. The entire sequence lasts for 25 seconds, and is accompanied by music and sound effects.

The collected issues of the Magazine, which are, of course, the CNG's *raison d'etre,* were converted to digital format through a process of scanning each cover and page of each issue into a computer. What the user of the CNG sees on his computer screen, therefore, is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text. Every cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine. The user can print out the image of any page of the Magazine, but the CNG does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way.

The Program, which was created by Mindscape, is the element of the software that enables the user to select, view, and navigate through the digital "pages" of the Magazine Replica on the CD-ROM. In creating the Program for the CNG, Mindscape incorporated two separate programs: the CD Author Development System ("CDA"), which is a search engine created by Dataware Technologies, Inc.; and the PicTools Development Kit ("PicTools"), which is a program for compressing and decompressing images that was created by Pegasus Imaging Corp.[3] The CNG package contains a "shrink-

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[3] Mindscape indicates that it has not registered a claim of copyright in the Program, which is manifestly copyrightable. *See* §§ 101 (defining "computer program"), 102; *Montgomery v. Noga,* 168 F.3d 1282, 1288 (11th Cir. 1999). However, copyright arises by operation of law upon fixation of an original work of authorship in a tangible medium of expression, which has clearly occurred in the case of the Program. *See* § 102; *Montgomery,* 168 F.3d at 1288. Moreover, Mindscape has represented to this court that two component elements of the Program, the CDA and PicTools, each of which are separately copyrightable computer programs, have been registered with the Copyright Office by Dataware Technologies, Inc., and Pegasus Imaging Corp., respectively. Because it consists of at least two other individually copyrighted works, the Program

(continued...)

wrap" license agreement in which "all rights [in the Program] not expressly granted are reserved by Mindscape or its suppliers." Without the Program, the Replica could still be stored on a CD-ROM, but the individual "pages" of the Magazine would not be efficiently accessible to the user of the CNG.

Prior to placing the CNG on the market, the Society dispatched a letter to each person who had contributed to the Magazine. This letter informed the contributors about the CNG product and stated the Society's position that it would not provide the contributors with any additional compensation for the digital republication and use of their works. Greenberg contends that he responded to this notice through counsel and objected to the Society's use of his photographs in the CNG, but he received no response from the Society.

The Society sought registration for its claim of copyright for the CNG in 1998, but noted 1997 as the year of its completion. On the registration form,[4] the Society indicated that the "nature of authorship" included photographs, text, and an "introductory audiovisual montage." The Society claimed that the work had not been registered before, but indicated that it was a derivative work, namely a "compilation of pre-existing material primarily pictorial," to which a "brief introductory audiovisual montage" had been added. No reference was made to, nor was there any disclosure of, the copyrightable Mindscape Program or the two pre-existing, copyrightable sub-programs that it incorporates, all of which are also components of the CNG. The box in which the CNG is packaged and each individual CD-ROM bear the mark "© 1997 National

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[3] (...continued)
meets the definition of both a "compilation" and a "collective work" under § 101 of the Act.

[4] A copy of the registration form (application), which when approved by the Copyright Office became the registration certificate, is attached hereto as Appendix A.

Geographic Society"—indicating the creation of a new work of authorship in 1997.

Greenberg initiated an infringement action against the Society, National Geographic Enterprises, and Mindscape, alleging five counts of copyright infringement, two of which are relevant here: count "III" addressed the Society's reuse of Greenberg's photographs in the CNG, generally, and count "V" specifically addressed the use of his diver photograph in the Sequence. The Society, together with the two other defendants, moved for summary judgment on counts III-V, arguing that it had a privilege under § 201(c) to reproduce and distribute Greenberg's photographs in the CNG because it owned the copyright in the original issues of the Magazine in which the photographs appeared.[5] Greenberg filed a cross-motion for summary judgment on count III. The district court, relying on the district court opinion in *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997), *rev'd*, 206 F.3d 161 (2d Cir. 2000), *cert. granted*, 69 U.S.L.W. 3312, 3316 (U.S. Nov. 6, 2000) (No. 00-201), held that the CNG constituted a "revision" of the paper copies of the Magazine that was within the Society's privilege under § 201(c), and accordingly granted summary judgment for all of the defendants on counts III-V. The district court later dismissed counts I and II, which did not relate to the CNG, at the parties' joint request. The Greenbergs appeal the district court's judgment only as to counts III and V.

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[5] There is no evidence in the record that would support the theory that National Geographic Enterprises or Mindscape, neither of which has a copyright interest in the original issues of the Magazine, somehow are privy to the privilege in § 201(c) enjoyed by the Society.

II. DISCUSSION

To evaluate the claims of infringement leveled by Greenberg against the defendants,[6] we must interpret and apply § 201(c) of the Act. That section constitutes the sole basis and defense of the Society's use of Greenberg's copyrighted photographs. In all cases involving copyright law, we understand that any interpretation and application of the statutory law must be consistent with the copyright clause of the United States Constitution; specifically, the eighth clause of the eighth section of Article I. That clause is a limitation, as well as a grant, of the copyright power.[7] The copyright clause,

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[6] In the Amended Complaint, Greenberg refers to Mindscape's and National Geographic Enterprises's liability as "at least vicarious." We construe this as an allegation of contributory copyright infringement. A contributory copyright infringer is "one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another." *Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845 (11th Cir. 1990) (citations omitted). Accordingly, there can be no contributory infringement without a finding that there was direct copyright infringement by another party. *Id.* Further, the CNG appears to be a "joint work," which is defined under § 101 as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." Here the two "authors," the Society and Mindscape ("authors" under the legal fiction created in § 201(b)), clearly intended their contributions of the Sequence, Replica, and Program to function and be presented as a unitary whole. The CNG also fits the definition of a "collective work" under § 101; that is, "a work . . . in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." The concept of the "collective work" is included within the term "compilation," which is defined in § 101 as "a work formed by the collection and assembling of preexisting materials . . . that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." Whether the CNG is considered a "joint work" or a "collective work" makes no difference in our analysis because under each definition, a work results that is copyrightable as an entity separate and distinct from its constituent, pre-existing, separately copyrightable contributions.

[7] *See* Paul J. Heald and Suzanna Sherry, "Implied Limits on the

(continued...)

consisting of twenty-four words crafted by our founding fathers, is the Rosetta Stone for all statutory interpretation and analysis. Accordingly, it is upon that predicate that we examine § 201(c) in the context of this case.[8]

The Society conceded that it has used Greenberg's photographs in a way that is inconsistent with his exclusive rights as an author under § 106.[9] However, the Society

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[7] (...continued)
Legislative Power: the Intellectual Property Clause as an Absolute Constraint on Congress," 2000 U. Ill. L. Rev. 1119 (2000).

[8] Appreciation of fundamental principles is required in all areas of the law, but is particularly important in the copyright arena. As observed by Professor L. Ray Patterson's opening remarks in his insightful article entitled "Understanding the Copyright Clause," 47 J. COPYRIGHT SOC'Y 365 (2000):

> Probably few industries as large as the copyright industry have rested on a legal foundation as slim as the twenty-four words of the copyright clause. And probably no foundation of comparable importance has been so little understood and so often ignored. This is all the more surprising because the components of the copyright industry-information/learning/entertainment-are so important to a free society, and because the history of the copyright clause is so well documented.

Id. at 365. The copyright clause provides: "The Congress shall have Power . . . To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings." U.S. Const. art. I, § 8, cl. 8.

[9] Section 106 reserves to the owner of a copyright the rights: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the
(continued...)

contends that it is privileged to make such use of the photographs under § 201(c), and therefore does not violate such exclusive rights and thus is not an infringer under § 501(a). Subpart "c" of § 201, entitled "Ownership of Copyright," provides:

> **(c) Contributions to Collective Works.** Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

In the context of this case, Greenberg is "the author of the contribution" (here each photograph is a contribution) and the Society is "the owner of copyright in the collective work" (here the Magazine). Note that the statute grants to the Society "only [a] privilege," not a right. Thus the statute's language contrasts the contributor's "copyright" and "any rights under it" with the publisher's "privilege." This is an important distinction that militates in favor of narrowly construing the publisher's privilege when balancing it against the constitutionally-secured rights of the author/contributor.

The Society argues that its use of Greenberg's photographs constitutes a "revision" of the Magazine ["that collective work"], referring to the CNG as the compendium of over 1,200 independent back issues; in copyright terms, a collective work of separate and distinct collective works, arranged in

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[9] (...continued)
case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

chronological order.[10] Assuming *arguendo,* but expressly not deciding, that 201(c)'s revision privilege embraces the entirety of the Replica portion of the CNG (the 1,200 issues, as opposed to each separate issue of the Magazine), we are unable to stretch the phrase "that particular collective work" to encompass the Sequence and Program elements as well. In layman's terms, the instant product is in no sense a "revision." In this case we do not need to consult dictionaries or colloquial meanings to understand what is permitted under § 201(c). Congress in its legislative commentary spelled it out in the concluding paragraph of its discussion of § 201(c) (which is identical in both the Senate and House versions):[11]

> The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it, *the publisher could not* revise the contribution itself or *include it in* a new anthology or *an* entirely different magazine or *other collective work.*

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[10] It does not satisfy the definition of "compilation" since inclusion of all issues of a publication in chronological order does not satisfy the minimum creativity necessary for the selection, coordination, or arrangement that would result in an original work of authorship. *See Warren Publ'g, Inc. v. Microdos Data Corp.,* 115 F.3d 1509, 1518-19 (11th Cir. 1997) (en banc) (holding that work incorporating "entire relevant universe" did not exhibit sufficient creativity in selection to merit copyright protection as a compilation).

[11] A reproduction of the entire discussion in the House and Senate Reports is set out in Appendix B.

H.R. Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738 (emphasis added).

As discussed above, the CNG is an "other collective work" composed of the Sequence, the Replica, and the Program. However, common-sense copyright analysis compels the conclusion that the Society, in collaboration with Mindscape, has created a new product ("an original work of authorship"), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c).[12]

This analysis is totally consistent with the conduct of the Society when it registered its claim of copyright in the CNG (under the title "108 Years of National Geographic on CD-ROM"). Under section "5" of the copyright registration form, in response to the question: "Has registration for this work, or for an earlier version of this work, already been made in the Copyright Office?"; the Society replied, "No." Accordingly, this was a new work. Registrations had already been made relative to individual issues of the Magazine. Under section

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[12] The Society characterizes this case as one in which there has merely been a republication of a preexisting work, without substantive change, in a new medium; specifically, digital format. As discussed in the text, however, this case is both factually and legally different than a media transformation. The Society analogizes the digitalization of the Magazine to the reproduction of the Magazine on microfilm and microfiche. While it is true that both the digital reproductions and the microfilm/microfiche reproductions require a mechanical device for viewing them, the critical difference, from a copyright perspective, is that the computer, as opposed to the machines used for viewing microfilm and microfiche, requires the interaction of a computer program in order to accomplish the useful reproduction involved with the new medium. These computer programs are themselves the subject matter of copyright, and may constitute original works of authorship, and thus present an additional dimension in the copyright analysis. Because this case involves not only the incorporation of a new computer program, but also the combination of the Sequence and the Replica, we need not decide in this case whether the addition of only the Program would result in the creation of a new collective work.

"6," subpart "a," the Society described the work (the CNG) as a "Compilation of pre-existing material primarily pictorial." Under section "6," subpart "b," which requested, "Material added to this work. Give a brief, general statement of the material that has been added to this work and in which copyright is claimed," the Society wrote "Brief introductory audiovisual montage." *See* Appendix A.[13] Thus, even the Society admitted that the registered work, the CNG, was a compilation. Recall that a collective work is included in the definition of compilation and embraces those works wherein its separate components are each themselves copyrightable-as are the Sequence, Replica, and Program (the "pre-existing materials" referred to in part [only the Replica was disclosed] by the Society in section "6."). Accordingly, in the words of the legislative report, "the publisher [the Society] could not . . . include [the contribution (the photographs)] in a new anthology . . . or other collective work [the CNG]." Thus in creating a new work the Society forfeited any privilege that it *might*[14]

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[13] As noted earlier, the Society failed to indicate the third, and critical, element of the new work, the Program. While the storage and retrieval system may be "transparent" to the unsophisticated computer user, it nevertheless is present and integral to the operation and presentation of the data and images viewed and accessed by the user. Giving the Society the benefit of the doubt, it may not have intentionally perpetrated a fraud on the Copyright Office.

[14] We indicate "*might*" because a persuasive argument can be made that when the Replica portion of the CNG was converted from text and picture images on a page to electronic, digital format, the statutory definition of a "derivative work" was not satisfied. A "derivative work" is defined under § 101 as:

> a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, *or any other form in which a work may be recast, transformed*, or adapted. A work consisting of editorial *revisions*, annotations, elaborations, or other modifications which,

(continued...)

have enjoyed with respect to only one component thereof, the Replica.

With respect to the Sequence and its unauthorized use of Greenberg's diver photograph, we find that the Society has infringed upon the photographer's exclusive right under § 106(2) to prepare derivative works based upon his copyrighted photograph. The Society has selected ten preexisting works, photographs included in covers of ten issues of the Magazine, including Greenberg's, and transformed them into a moving visual sequence that morphs one into the other over a span of approximately 25 seconds. Moreover, the Society repositioned Greenberg's photograph from a horizontal presentation of the diver into a vertical presentation of that diver. Manifestly, this Sequence, an animated, transforming selection and arrangement of preexisting copyrighted photographs constitutes at once a compilation, collective work, and, with reference to the Greenberg photograph, a derivative work. *See Warren Publ'g,* 115 F.3d at 1515 n. 16.

The Society argues that its use of Greenberg's diver photograph was a fair use under § 107.[15] Guided by the

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[14] (...continued)

> *as a whole*, represent an original work of authorship, is a "derivative work".

(Emphasis added). Note that in order to qualify as a derivative work, the resulting work (including "revisions") after transformation must qualify as an "original work of authorship." Thus, the mere electronic digital reproduction that represents the Replica may not qualify as a derivative work, and thus not violate Greenberg's exclusive right to prepare derivative works under § 106. *See* supra note 10. This derivative-works issue may be addressed by the Supreme Court in *Tasini v. New York Times Co.,* 972 F. Supp. 804 (S.D.N.Y.1997), *rev'd,* 206 F.3d 161 (2d Cir. 2000), *cert. granted,* 69 U.S.L.W. 3312, 3316 (U.S. Nov. 6, 2000) (No. 00-201). But here, as explained above, we have far more than a mere reproduction in another medium.

[15] Among the factors to be considered in determining whether a use of a copyrighted work is a "fair use" are:

(continued...)

principles explained in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 114 S. Ct. 1164 (1994),[16] we find that the Society has neither a fair use defense or right. *See Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 n. 22 (11th Cir. 1996); David Nimmer, "An Odyssey through Copyright's Vicarious Defenses," 73 N.Y.U. L. Rev. 162, 191 (1998). The use of the diver photograph far transcended a mere reprinting or borrowing of the work. As explained above, it became an integral part of a larger, new collective work. The use to which the diver photograph was put was clearly a transformative use. The Sequence reflects the transformation of the photograph as it is faded into and out of the preceding and following photographs (after having turned the horizontal diver onto a vertical axis). The Sequence also integrates the visual presentation with an audio presentation consisting of copyrightable music. The resultant moving and morphing visual creation transcends a use that is fair within the context of § 107. Moreover, while the CNG is a product that may serve educational purposes, it is marketed to the public at book stores, specialty stores, and over the Internet. The Society is a non-profit organization, but its subsidiary National Geographic Enterprises, which markets and distributes the CNG, is not; the sale of the CNG is clearly for profit. Finally, the inclusion of

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[15] (...continued)

> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
> (2) the nature of the copyrighted work;
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

[16] In *Campbell*, the Supreme Court indicated that the statutory factors in § 107 should not "be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright." 510 U.S. at 578, 114 S. Ct. at 1170-71.

Greenberg's diver photograph in the Sequence has effectively diminished, if not extinguished, any opportunity Greenberg might have had to license the photograph to other potential users.[17]

Alternatively, the Society contends that its use of Greenberg's diver photograph, which appeared on the cover of the January 1962 issue of the Magazine, constitutes a *de minimis* use and thus is not actionable. We find no merit in that argument in the context of this derivative and collective work, the Sequence.

In assessing a *de minimis* defense, we must examine both the *quality* and *quantity* of the use.[18] Greenberg's photograph is one of ten selected and arranged by the Society and constitutes one-tenth of the entire Sequence; a pro-rata share. Thus, when comparing the entire work with the contribution at issue, it clearly represents a significant portion of the new work. This is particularly accentuated in a qualitative way when we consider that only ten covers from a universe of some 1200 covers of the Magazine, embracing 108 years of publication, were selected for this composition. Moreover, the instruction materials that accompany the CD-ROM discs inside the CNG product box refer to the Sequence as "The Complete National Geographic *icon*" (emphasis added). *[R1- 20-Ex. A]*

Each and every time a user of the CNG views any of the 30 discs, the user views the Sequence-the projection of the Sequence is automatic without any prompting from the user.

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[17] The inclusion by the Society of Greenberg's photograph in a newly copyrighted work, the Sequence, clearly indicates that the Society claims certain copyright rights in the photograph, with which potential licensees or assignees of the photograph would have to be concerned.

[18] *See Horgan v. Macmillan, Inc.*, 789 F.2d 157, 162 (2d Cir. 1986) ("Even a small amount of the original, if it is qualitatively significant, may be sufficient to be an infringement."); *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, 900 F. Supp. 1287, 1300 (C.D. Cal. 1995) ("[T]he court must look to the quantitative and qualitative extent of the copying involved.").

Thus, the use of the Sequence in the context of the entire CNG is not a *de minimis* use that fails to reach the threshold of actionable copyright infringement. The two cases principally relied upon by the Society, *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70 (2d Cir. 1997), and *Amsinck v. Columbia Pictures Indus., Inc.*, 862 F. Supp. 1044 (S.D.N.Y. 1994), are not to the contrary. The "iconic" display at the beginning of each disc in the CNG product argues against the suggestion that the use of the Sequence in the CNG or the use of the Greenberg diver photograph in the Sequence is inconsequential. Accordingly, because we find the unauthorized use of the subject photograph to be both qualitatively and quantitatively significant, we reject the *de minimis* defense advanced by the Society and its putative co-infringers.

III. CONCLUSION

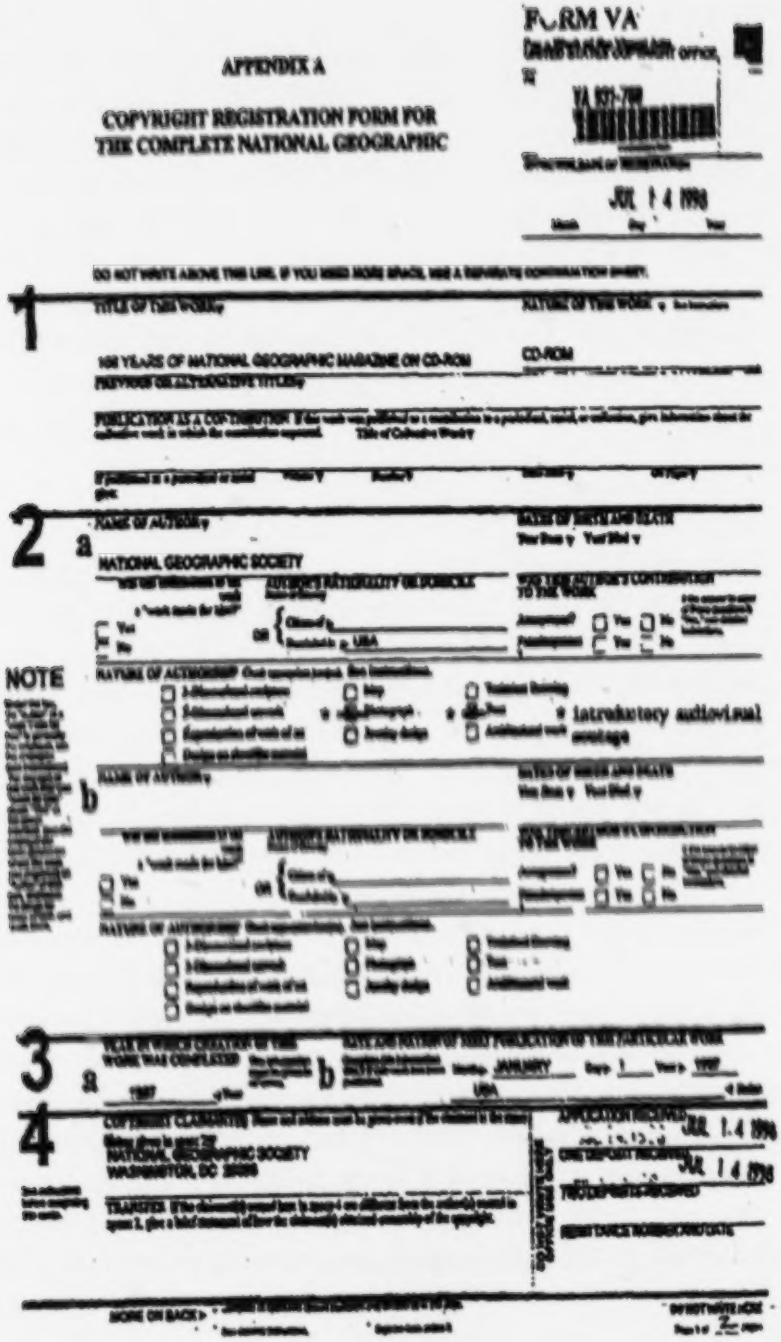
We conclude that the unauthorized use of the Greenberg photographs in the CNG compiled and authored by the Society constitutes copyright infringement that is not excused by the privilege afforded the Society under § 201(c). We also find that the unauthorized use of Greenberg's diver photograph in the derivative and collective work, the Sequence, compiled by the Society, constitutes copyright infringement, and that the proffered *de minimis* use defense is without merit. ~~Upon remand, the court below is directed to enter judgment on these copyright claims in favor of Greenberg. Counsel for the appellant should submit its documented claims for attorneys fees relative to this appeal to the district court for review and approval. We find the appellant to be the prevailing party on this appeal and, therefore, is entitled to an award of costs and attorneys fees.~~ Upon remand, the district court should ascertain the amount of damages and attorneys fees that are due, if any, as well as any injunctive relief that may be appropriate. In assessing the appropriateness of injunctive relief, we urge the court to consider alternatives, such as mandatory license fees,

in lieu of foreclosing the public's computer-aided access to this educational and entertaining work.

REVERSED and **REMANDED.**

APPENDIX A

COPYRIGHT REGISTRATION FORM FOR
THE COMPLETE NATIONAL GEOGRAPHIC


FORM VA

VA 831-799

JUL 14 1998

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

1 TITLE OF THIS WORK ▼ NATURE OF THIS WORK ▼

100 YEARS OF NATIONAL GEOGRAPHIC MAGAZINE ON CD-ROM CD-ROM

PREVIOUS OR ALTERNATIVE TITLES ▼

PUBLICATION AS A CONTRIBUTION If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. Title of Collective Work ▼

If published in a periodical or serial give: Volume ▼ Number ▼ Issue Date ▼ On Pages ▼

2 a NAME OF AUTHOR ▼ DATES OF BIRTH AND DEATH Year Born ▼ Year Died ▼

NATIONAL GEOGRAPHIC SOCIETY

Was this contribution to the work a "work made for hire"? Yes / No

AUTHOR'S NATIONALITY OR DOMICILE Name of Country OR Domiciled in ▼ USA

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK Anonymous? Yes / No Pseudonymous? Yes / No

NATURE OF AUTHORSHIP Check appropriate box(es). See instructions.

3-Dimensional sculpture; Map; Technical drawing; 2-Dimensional artwork; Photograph; Text; Reproduction of work of art; Jewelry design; Architectural work; Design on useful article

NOTE: Under the law, the "author" of a "work made for hire" is generally the employer, not the employee (see instructions). For any part of this work that was "made for hire" check "Yes" in the space provided, give the employer (or other person for whom the work was prepared) as "Author" of that part, and leave the space for dates of birth and death blank.

Introductory audio/visual montage

b NAME OF AUTHOR ▼ DATES OF BIRTH AND DEATH Year Born ▼ Year Died ▼

Was this contribution to the work a "work made for hire"? Yes / No

AUTHOR'S NATIONALITY OR DOMICILE Name of Country OR Domiciled in ▼

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK Anonymous? Yes / No Pseudonymous? Yes / No

NATURE OF AUTHORSHIP Check appropriate box(es). See instructions.

3-Dimensional sculpture; Map; Technical drawing; 2-Dimensional artwork; Photograph; Text; Reproduction of work of art; Jewelry design; Architectural work; Design on useful article

3 a YEAR IN WHICH CREATION OF THIS WORK WAS COMPLETED 1997 Year ▼

b DATE AND NATION OF FIRST PUBLICATION OF THIS PARTICULAR WORK Month JANUARY Day 1 Year 1997 USA Nation ▼

4 COPYRIGHT CLAIMANT(S) Name and address must be given even if the claimant is the same as the author given in space 2. ▼

NATIONAL GEOGRAPHIC SOCIETY
WASHINGTON, DC 20036

TRANSFER If the claimant(s) named here in space 4 are different from the author(s) named in space 2, give a brief statement of how the claimant(s) obtained ownership of the copyright. ▼

APPLICATION RECEIVED JUL 14 1998

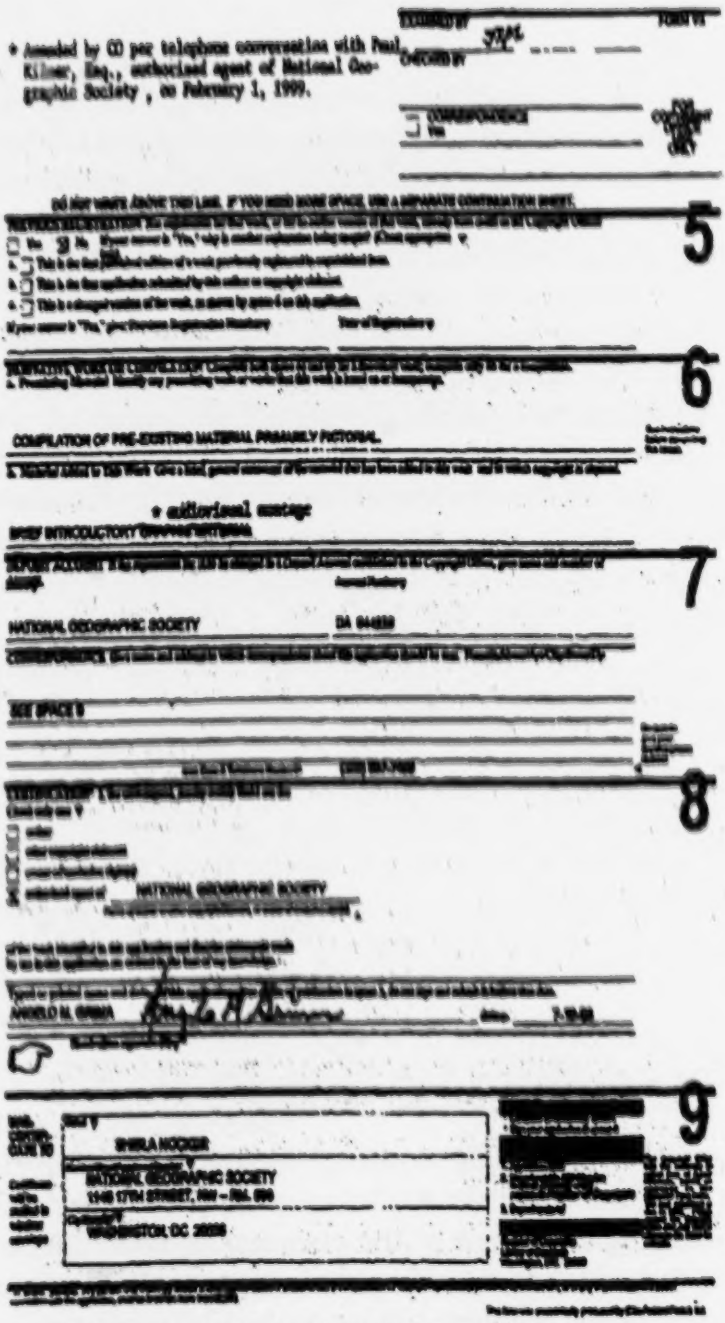
ONE DEPOSIT RECEIVED JUL 14 1998

TWO DEPOSITS RECEIVED

FUNDS RECEIVED

MORE ON BACK ▶ DO NOT WRITE ABOVE

BEST AVAILABLE COPY



* Amended by CO per telephone conversation with Paul Kilmer, Esq., authorized agent of National Geographic Society , on February 1, 1999.

5

6

COMPILATION OF PRE-EXISTING MATERIAL PRIMARILY PICTORIAL.

* additional matter

7

NATIONAL GEOGRAPHIC SOCIETY

SEE SPACE 9

8

NATIONAL GEOGRAPHIC SOCIETY

9

SHEILA HOCKER

NATIONAL GEOGRAPHIC SOCIETY
1145 17TH STREET, NW – RM. 000

WASHINGTON, DC 20036

APPENDIX B

EXCERPT FROM H.R. 94-1476 (1976) *reprinted in* 1976 U.S.C.C.A.N. 5659

Contributions to collective works

Subsection (c) of section 201 deals with the troublesome problem of ownership of copyright in contributions to collective works, and the relationship between copyright ownership in a contribution and in the collective work in which it appears. The first sentence establishes the basic principle that copyright in the individual contribution and copyright in the collective work as a whole are separate and distinct, and that the author of the contribution is, as in every other case, the first owner of copyright in it. Under the definitions in section 101, a "collective work" is a species of "compilation" and, by its nature, must involve the selection, assembly, and arrangement of "a number of contributions." Examples of "collective works" would ordinarily include periodical issues, anthologies, symposia, and collections of the discrete writings of the same authors, but not cases, such as a composition consisting of words and music, a work published with illustrations or front matter, or three one-act plays, where relatively few separate elements have been brought together. Unlike the contents of other types of "compilations," each of the contributions incorporated in a "collective work" must itself constitute a "separate and independent" work, therefore ruling out compilations of information or other uncopyrightable material and works published with editorial revisions or annotations. Moreover, as noted above, there is a basic distinction between a "joint work," where the separate elements merge into a unified whole, and a "collective work," where they remain unintegrated and disparate.

The bill does nothing to change the rights of the owner of copyright in a collective work under the present law. These exclusive rights extend to the elements of compilation and editing that went into the collective work as a whole, as well as the contributions that were written for hire by employees of the

owner of the collective work, and those copyrighted contributions that have been transferred in writing to the owner by their authors. However, one of the most significant aims of the bill is to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions.

The second sentence of section 201(c), in conjunction with the provisions of section 404 dealing with copyright notice, will preserve the author's copyright in a contribution even if the contribution does not bear a separate notice in the author's name, and without requiring any unqualified transfer of rights to the owner of the collective work. This is coupled with a presumption that, unless there has been an express transfer of more, the owner of the collective work acquires "only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series."

The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution publisher could not revise the contribution itself or include it in a new anthology or an entirely different itself or include it in a new anthology or an entirely different magazine or other collective work.

APPENDIX B

June 8, 2001

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG,
IDAZ GREENBERG,
Plaintiffs-Appellants,

v.

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, *et. al.*,
Defendants-Appellees.

Docket No. 00-10510-CC

On Appeal from the United States District Court for
the Southern District of Florida

ON PETITION(S) FOR REHEARING AND
PETITION(S) FOR REHEARING EN BANC
(Opinion _____, 11th Cir., 19___, ____F.2d____).

Before: ANDERSON, Chief Judge, TJOFLAT and BIRCH, Circuit Judges.

Per Curiam

The Petition(s) for Rehearing are DENIED and no member of this panel nor other Judge in regular active service on the

Court having requested that the Court be polled on rehearing en banc (Rule 35, Federal Rules of Appellate Procedure; Eleventh Circuit Rule 35-5), the Petition(s) for Rehearing En Banc are DENIED.

ENTERED FOR THE COURT

/s/ Stanley F. Birch, Jr.
UNITED STATES CIRCUIT JUDGE

APPENDIX C

April 20, 2001

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG,
IDAZ GREENBERG,
Plaintiffs-Appellants,

v.

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, *et. al.*,
Defendants-Appellees.

Docket No. 00-10510-CC

On Appeal from the United States District Court for
the Southern District of Florida

ORDER

The motion by amici curiae Magazine Publishers of America, *et. al.*, for leave to file a petition for rehearing en banc is DENIED.

/s/ Stanley F. Birch, Jr.
UNITED STATES CIRCUIT JUDGE

APPENDIX D

KIRKLAND & ELLIS
PARTNERSHIPS INCLUDING PROFESSIONAL CORPORATIONS

655 Fifteenth Street N.W.
Washington, D.C. 20005

(202) 879-5000 Facsimile: 202 879-5200

Kenneth W. Starr
To Call Writer Directly:
(202) 879-5130
kenneth_starr@dc.kirkland.com

May 2, 2001

VIA MESSENGER

Mr. Thomas K. Kahn
Clerk of Court
United States Court of Appeals
for the Eleventh Circuit
56 Forsyth Street, N.W.
Atlanta, GA 30303

Re: *Greenberg v. National Geographic Society, et al.*,
Docket No. 00-10510
Amendment to Petition for Rehearing *En Banc*

Dear Mr. Kahn:

We received on Monday, April 30, the "corrected opinion" in the above-captioned case. Because this corrected opinion addresses one of the questions raised in our petition for rehearing (Question Number 3 concerning the award of attorneys' fees) and the error concerning entry of judgment for the plaintiffs pointed out at page 14, footnote 3, of the petition, we wish to notify the entire *en banc* court that we respectfully withdraw Question Number 3 (pp. 13-14) and that portion of

the brief concerning entry of judgment for the plaintiffs (p. 14, note 3).

In addition to the merits of our petition relating to Section 201(c) of the Copyright Act (addressed in Question 1 of our petition), the corrected opinion fails to correct the accusation of "fraud" on the Copyright Office by National Geographic at footnote 13 of the opinion, which is addressed in Question 2 of our petition. We have today received a letter from the General Counsel of the Copyright Office of the United States, David Carson, bearing directly on the appropriateness of the registration filed by the National Geographic Society in the application process with the Copyright Office.

We respectfully request that you provide this letter to all of the active judges considering the petition and the attached letter from the Copyright Office of the United States.

Respectfully submitted,

/s/

Kenneth W. Starr

cc: Norman Davis, Esq.

LIBRARY OF CONGRESS
COPYRIGHT OFFICE
101 Independence Avenue, S.E.
Washington, D.C. 20559-6000

May 2, 2001

Terrence B. Adamson
Executive Vice President
The National Geographic Society
1145 17th Street, NW
Washington, DC 20036-4688

Re: Greenberg v. National Geographic Society

Dear Mr. Adamson:

We are writing in response to your letter of April 5, 2001, relating to the decision of the United States Court of Appeals for the Eleventh Circuit in *Greenberg v. National Geographic Society*, No. 00-10510.

Although the Copyright Office does not often comment on the merits of private civil litigation, the court's remarks about the National Geographic Society's possible fraud on the Copyright Office appear to reveal a misunderstanding of Copyright Office registration practices. In the rare cases in which appellate courts discuss our registration practices in a way that is likely to confuse the public, we will speak out in the interests of justice, public education and the orderly administration of the copyright laws. See the Office's Statement of Policy, 65 Fed. Reg. 41,508 (July 5, 2000), and *Raquel v. Education Management Corp.*, 121 S. Ct. 376 (2000) (granting writ of certiorari, vacating the decision of the court of appeals, and remanding "for further consideration in light of

the position asserted by the Solicitor General in his brief for the United States, as *amicus curiae*, filed September 20, 2000, and the Copyright Office's July 5, 2000, Statement of Policy, 65 Fed. Reg. 41,508").

In this case, we are pleased to set the record straight and confirm that having reviewed certificate of registration no. VA 931-760 as well as the registered work, "108 Years of National Geographic Magazine CD-ROM," we find that the National Geographic Society's application complied with the Office's requirements for registration, and that there is no reason to conclude that the application misled the Office in any way. To the extent that your letter invites the Office to express its views on the merits in general of the Eleventh Circuit's opinion in *Greenberg*, we must decline the invitation. Although the Office has misgivings about the *Greenberg* opinion in a number of respects, we do not believe that this is the appropriate occasion to express our views, apart from explaining how the court misunderstood the Office's registration practices.

The statement in *Greenberg* that has caused concern in the Office appears in a footnote:

> As noted earlier, the Society failed to indicate the third, and critical, element of the new work, the Program. While the storage and retrieval system may be "transparent" to the unsophisticated computer user, it nevertheless is present and integral to the operation and presentation of the data and images viewed and accessed by the user. *Giving the Society the benefit of the doubt, it may not have intentionally perpetrated a fraud on the Copyright Office.*

Slip opinion at 14, n. 13 (emphasis added). This statement casts doubt on the National Geographic Society's conduct in

connection with its application to register "108 Years of National Geographic Magazine CD-ROM," and on a standard practice in registration of copyrights in works on media such as CD-ROMs.

The court of appeals appears to have erroneously concluded that certificate of registration No. VA 931-760 purports to be a registration of the entire contents of the CD-ROM series constituting "108 Years of National Geographic Magazine CD-ROM."* Our review leads us to a very different conclusion: the certificate purports to register the copyright only in what is described on the face of the certificate as "brief introductory audiovisual montage." It is apparent that this is a reference to what the *Greenberg* opinion refers to as the "moving covers sequence," or simply the "Sequence." See slip op. at 4.

To understand what copyrighted material is being registered, one must carefully examine the application for registration. Although space 1 of the application states that the title of the work is 108 Years of National Geographic Magazine on CD-ROM," space 2 describes the "nature of authorship" as "introductory audiovisual montage." As the *Compendium of Copyright Office Practices, Compendium II* states, "In general, the nature of authorship defines the scope of the registration; therefore, it represents an important copyright fact." *Compendium II*, §619 (1988); see also Statement of Policy, 65 Fed. Reg. 41,508 (July 5, 2000). Thus, the entry in space 2 clarifies that what is being registered is that introductory sequence, rather than the entire contents of the CD-ROMs on which the sequence appears.

Moreover, the entries in space 6 further clarify that the only subject matter being registered is the introductory sequence. Space 6 of an application for copyright registration seeks

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* The application for registration is reproduced in its entirety as part of the certificate of registration.

information about compilations and derivative works. Space 6 of certificate of registration No. VA 931-760 clearly identifies the work being registered as a derivative work, stating in space 6a that the preexisting material includes a "compilation of pre-existing material primarily pictorial," and stating in space 6b that the "material that has been added to this work and in which copyright is claimed" consists of a "brief introductory audiovisual montage."** The court's conclusion that the certificate of registration reveals that "the registered work, the CNG, was a compilation," slip op. at 14, is thus based on a misinterpretation of the certificate. While the certificate states that the preexisting material was a compilation, it does not state that the additional material, the "audiovisual montage," was a compilation. Of course, it is possible to view that audiovisual montage as a compilation—but that compilation would simply be a compilation of covers from past issues of the National Geographic magazine, not a compilation of, in the words of the court, "the Sequence, the Replica, and the Program." See slip op. at 13.

Hence, the National Geographic Society's application for copyright registration clearly sought registration only of the copyright in the introductory sequence. The Office clearly understood this and issued the certificate of registration based on that understanding.***

** See Copyright Office Circular 55, *Copyright Registration for Multimedia Works*, at 4 ("**New Material Added (6b)**. Briefly describe all the new copyrightable authorship that is the basis of the present registration. An example is: 'some new text, new photography.' (The statement used in 6b may be used in space 2 to describe the author's contribution.)").

*** The certificate indicates that the information in spaces 2 and 6a was amended by a Copyright Office examiner as a result of a telephone conversation with an attorney representing the National Geographic Society. This is a common practice when the examiner believes that clarification of

(continued...)

Accordingly, there can be no question of any attempt to perpetrate a fraud on the Copyright Office, and the court's speculation in footnote 13 of the opinion is inconsistent with the Copyright Office registration record for this particular work.

There is another reason why the court's reference to possible fraud on the Copyright Office is inconsistent with the Office's actual examination and registration practices. A trained examiner understands that a straight, chronological replication of 108 years' worth of National Geographic Magazine does not rise to the level of copyrightable compilation authorship because of the lack of the statutorily required selection, coordination or arrangement. However, assuming that the National Geographic Society had attempted to register a copyright in the entire compilation of 108 years of issues of the National Geographic magazine on CD-ROM, the court appears to have implied that the Society may have attempted to conceal from the Office the presence of the software that is included on the CD-ROM to enable users to gain access to the contents of the magazine issues, and that this possible concealment may have been intended to avoid the consequences that would have ensued if the Office had been

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*** (...continued)
the copyright claim is needed. The original application included a claim in "photograph" and "text," but following the telephone conversation, those claims were deleted, apparently because the examiner explained to the attorney that the photographs and text in question were part of a straight, chronological replication of 108 years' worth of issues of National Geographic Magazine, which a trained examiner would understand as not rising to the level of copyrightable compilation authorship because of the lack of the statutorily required selection, organization or arrangement. The attorney authorized the examiner to delete the references to "photograph" and "text," and to insert the references to "introductory audiovisual montage." Thus, the application in its final form claimed copyright only in a very limited portion of the content on the CD-ROM, and the Office was aware of this.

aware of the presence of the software on the CD-ROM. We infer this because of the court's reference to "fraud on the Copyright Office." The doctrine of fraud on the Copyright Office provides that the knowing submission of a misleading application for copyright registration may invalidate the resulting registration if awareness of the true facts might have caused the Copyright Office to deny registration. See *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 456 (2d Cir. 1989); *S.O.S., Inc. v Payday, Inc.*, 886 F.2d 1081, 1086 (9th Cir. 1989); 2 M. & D. Nimmer, *Nimmer on Copyright* § 7.20[B], at 7-209 (2000).

If this is what the court was thinking, the court misunderstood another aspect of copyright registration practice. The Copyright Office recognizes that when works of authorship embodied in CD-ROM format are submitted for registration, computer programs may be included on the same CD-ROM, and that use of those computer programs may be necessary in order for a user to gain access to the work of authorship in which copyright is claimed. However, it is not necessary in such cases that the application for copyright registration include a claim of copyright in the software.

The Copyright Office Examining Division examines works of authorship embodied in CD-ROM format also according to its "Interim CD-ROM Practices, Literary Section, Rev. 2/95."**** The Practices acknowledge that a single CD-ROM disc may contain "many different types of material, including text, still images: photographs and illustrations, artwork, maps, sounds . . ., motion pictures . . ., computer software code . . ." and that "computer program text is only one of the elements that can be stored on a CD-ROM disc." CD-ROM Practices at 1. The Practices further state that "the author of the material on

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**** Although the Practices are titled "Literary Section," they apply to registration claims received in all classes of authorship and are used by all examiner staff within the Division.

the CD-ROM can also be the author of the retrieval software. Sometimes, however, a company will put together the material on the CD-ROM but use preexisting operating software which may or may not belong to that same company." CD-ROM Practices at 2.

Under these practices, an examiner will accept an application for registration in which no claim is specifically made for the retrieval software embodied in the CD-ROM as long as there is no information elsewhere on the application or on the deposit copy of the CD-ROM itself which indicates that the software may be owned by the same party claiming copyright in the substantive content of the CD-ROM. This is consistent with the Division's CD-ROM Practices noted above, which explicitly recognize that the copyright owner of some or all of the substantive content fixed in the CD-ROM may not be the same party that owns the copyright in the retrieval software present on the CD-ROM. Further, an examiner will also accept an application for registration in which no claim is specifically made for the software even if it is factually the case that the same party does own both the substantive content *and* the retrieval software embodied in the CD-ROM. The reason for the latter is that as long as the claim is facially acceptable, *i.e.*, all registration requirements for the authorship explicitly claimed have been met, the examiner will not investigate further and will not communicate with the applicant, according to the general examining principles in *Compendium II*, to determine whether the applicant wishes to extend the scope of the claim. In other words, if the applicant is entitled to claim copyright in the software but elects not to assert that claim, the Examining Division will not require the applicant to make the claim. The Examining Division assumes that the applicant has accurately described the extent of the authorship for which registration is sought. Moreover, if the applicant subsequently finds that the description of the extent of the authorship is incorrect and that additional authorship should have been

claimed, a supplementary registration may be made under 37 C.F.R. 201.5.

Thus, after review of the registration in question by appropriate supervisory examiner staff, the Office considers the registration no. VA 931-760 for the "introductory audiovisual montage" in the work "108 Years of National Geographic Magazine on Cd-ROM" to be valid because the registration was made within required examining guidelines. The National Geographic Society had no obligation to disclose or assert a copyright claim in the software.

The Copyright Office provides information to the public about its examining and registration practices in a series of circulars, including Circular 55, *Copyright Registration for Multimedia Works*. Circular 55 explains that although "All copyrightable elements of a multimedia kit may generally be registered with a single application, deposit and fee . . . [s]eparate registrations for individual elements may be made by submitting a separate application and filing fee each." Circular 55, at 2. Of particular significance with respect to registration no. VA 931-760, the Circular also states:

> "A separate registration is required, however, for any element of a multimedia kit that is published separately or claimed by someone other than the copyright claimant for the other elements."

Circular 55, at 2. According to the opinion in *Greenberg*, the software that was included on the CD-ROM was created not by the National Geographic Society, but by Mindscape, Inc. Slip op. at 5. Moreover, the court appears to have concluded that Mindscape owns the copyright in the software. Slip op. at 6 n.3. If that is the case, the National Geographic Society could not have claimed copyright in the software, whether as part of the application for registration of "108 Years of National Geographic Magazine CD-ROM" or separately.

We understand that the court of appeals viewed the entire CD-ROM as a compilation, and that the elements of that compilation included (1) the "Sequence," (2) the digitally reproduced issues of the magazine themselves, and (3) the software that enables users to gain access to the contents of the magazine issues. However, although this letter will not express a view on the merits of that analysis and its implications with respect to what a publisher may do pursuant to 17 U.S.C. § 201(c), we can clarify that the Office's examining practices do not require the owner of the copyright in content that is included on a CD-ROM, and which can be accessed only by using software that is also included on the CD-ROM, to claim compilation authorship with respect to all of the contents (including the software) on the CD-ROM.

In conclusion, based on the facts as we understand them, we believe that the suggestion by the court of appeals that the National Geographic Society may have "perpetrated a fraud on the Copyright Office" when it submitted its application for registration no. VA 931-760 is based on a misunderstanding of copyright registration practices.

We hope that this letter assists in clarifying that the National Geographic Society's application as amended was consistent with Copyright Office policies and practices.

Sincerely,

/s/

David O. Carson
General Counsel

cc: Norman Davis, Esq.

APPENDIX E

May 16, 2001

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG,
IDAZ GREENBERG,
Plaintiffs-Appellants,

v.

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia corporation,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.,
a corporation, *et. al.*,
Defendants-Appellees.

Docket No. 00-10510-CC

On Appeal from the United States District Court for
the Southern District of Florida

ORDER

Appellant's motion to strike the "Amendment to Petition for Rehearing" filed on May 3, 2001, by Appellee National Geographic Society, is GRANTED.

Appellant's motion for permission to respond to Appellees' rehearing petition, as amended, is DENIED, as moot.

/s/ Stanley F. Birch, Jr.
UNITED STATES CIRCUIT JUDGE

APPENDIX F

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 97-3924-CIV-LENARD

JERRY GREENBERG, individually
IDAZ GREENBERG, individually,

Plaintiffs,

vs.

NATIONAL GEOGRAPHIC SOCIETY, a District of Columbia corporation, NATIONAL GEOGRAPHIC ENTERPRISES, INC., a corporation, and MINDSCAPE, INC., a California corporation,

Defendants.

ORDER GRANTING IN PART AND DENYING IN PART DEFENDANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT

FILED MAY 14, 1998

THIS CAUSE comes before this Court upon Defendants' motion to dismiss and/or for summary judgment (D.E. 18), Plaintiff's cross-motion for summary judgment (D.E. 26), Plaintiff's motion for voluntary dismissal (D.E. 24), and Defendants' motion for oral argument (D.E. 28).

In 1990, Jerry Greenberg (Greenberg) provided National Geographic Society (Society) with a photograph he had taken

of a sea fan, for publication in the July 1990 issue of Society's magazine. Without Greenberg's permission, in 1996 Society reprinted the photograph in a promotional brochure. In 1995 and 1996, also without Greenberg's authorization, Society supplied other photographs taken by Greenberg, including those of a redband parrotfish, a spotlight parrotfish, and a green moray, to Educational Insights, Inc. (Insights), which used them in one of its products.

In 1997, Society, through National Geographic Enterprises, Inc. (Enterprises) and Mindscape, Inc. (Mindscape), produced and began to sell a 30 disc CD-ROM set, entitled The Complete National Geographic, which contains every issue ever published of Society's magazine. A number of the magazines published by Society over the years apparently contain photographs taken by Greenberg. At the beginning of each of the 30 discs in the CD-ROM set is an introduction to The National Geographic which consists of a sequence of ten of the magazine's covers. On one of those covers, from the magazine's January 1962 issue, is a photograph, taken by Greenberg, of a woman scuba diving around a coral reef.

On December 5, 1997, Plaintiff Greenberg filed an action in this Court for copyright infringement against Society, Enterprises and Mindscape. Greenberg alleges that Society infringed his copyright by providing his photographs of a redband parrotfish, a spotlight parrotfish and a green moray to Insights for use in its products (count I), and by reprinting his photograph of a sea fan in a 1996 promotional brochure (count II). Greenberg also alleges that Society, Enterprises and Mindscape infringed his copyright by reproducing a number of his photographs in The Complete National Geographic. On January 30, 1998, Defendants filed a motion to dismiss counts II through V of Greenberg's complaint and, in the alternative, a motion for summary judgment on counts III through V. As Greenberg and Defendants have supplemented their pleadings

with evidence, the Court will treat both of these motions as requests for summary judgment.

A motion for summary judgment may be granted only if no genuine dispute exists as to any material fact. Fed. R. Civ. P. 56(c). In deciding whether there is a genuine issue of material fact, the Court must view the pleadings, affidavits and other evidence in the record "in the light most favorable to the non-moving party." *Retina Associates, P.A. v. Southern Baptist Hosp. of Florida, Inc.*, 105 F.3d 1376, 1380 (11th Cir. 1997).

Defendants first contend that counts II through V of Greenberg's complaint must be dismissed, pursuant to 17 U.S.C. § 411(a), because there is no evidence that he registered his copyright in the photograph of the sea fan which Society printed in its 1996 promotional brochure, or in any of the photographs published in Society's magazines, including that of a woman scuba diving around a coral reef. Indeed, "copyright registration is a pre-requisite to the institution of a copyright infringement lawsuit." *Arthur Rutenberg Homes, Inc. v. Drew Homes, Inc.*, 29 F.3d 1529, 1532 (11th Cir. 1994). Greenberg has provided the Court with evidence, however, that on December 18, 1995 Society assigned to him the copyrights in these photographs, and that he subsequently renewed those copyrights prior to the time of their expiration. Exhibit B, 1-3, Plaintiff's Memorandum in Opposition to Defendants' Motion to Dismiss or for Summary Judgment.

Defendants next argue, pursuant to 17 U.S.C. § 201(c), that counts III through V of Greenberg's complaint must be dismissed because Defendants are permitted to reproduce and distribute, in The Complete National Geographic, photographs taken by Greenberg, including his photograph of a woman scuba diving around a coral reef, which were previously published in Society's magazines.

Under 17 U.S.C. § 201(c):

> Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as a part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c). Defendants concede that the previous issues of Society's magazines in which Greenberg's photographs were published are collective works in which Defendants were permitted to reproduce Greenberg's photographs. They submit, however, that The Complete National Geographic constitutes a 'revision' of that collective work within the meaning of 17 U.S.C. § 201(c). Greenberg disagrees.

The Court has only been able to locate one published opinion, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997), in which a court has addressed the issue whether a collective work is a revision within the meaning of this statute. In that case, a number of freelance writers whose articles were published in several widely read periodicals sued those periodicals and two companies to which the periodicals sold the writers' articles, one of which provided its subscribers with the texts of the articles electronically and the other of which distributed the texts on CD-ROM, for copyright infringement. The defendants argued that the electronic databases and the CD-ROM's promulgating the writers' articles were 'revisions' of the periodicals, collective works, within the meaning of 17 U.S.C. § 201(c).

The court observed that:

> If defendants change the original selection and arrangement of their newspapers or magazines, however, they are at risk of creating new works, works no longer recognizable as versions of the periodicals that are the source of their rights. Thus, in whatever ways they change their collective works, defendants must preserve some significant original aspect of those works—whether an original selection or an original arrangement—if they expect to satisfy the requirements of Section 201(c). Indeed, it is only if such a distinguishing original characteristic remains that the resulting creation can fairly be termed a revision of "that collective work" which preceded it.

Tasini, 972 F. Supp. at 821. In order to determine whether the electronic databases and CD-ROMs constituted a 'revision' of the periodicals, the court explained that a two-pronged inquiry is necessary. First, a court must identify any original selection or arrangement of materials in the collective work. Second, if the court concludes that the collective work possesses any such original selection or arrangement of materials, it must determine whether these characteristics are preserved electronically. *Tasini*, 972 F. Supp. at 821. The *Tasini* court then concluded that:

> If the disputed periodicals manifest an original selection or arrangement of materials, and if that originality is preserved electronically, then the electronic reproductions can be deemed permissible revisions of the publisher defendants' collective works. If, on the other hand, the electronic defendants do not preserve the originality of the disputed publications, but merely exploit the component parts of those

> works, then plaintiffs' rights in those component parts have been infringed.

Tasini, 972 F. Supp. at 822. This Court finds the *Tasini* Court's reasoning sound and therefore adopts the legal framework developed by that court to analyze the legal question currently before this Court.

Society indisputably selected and arranged the articles and photographs in each issue of its magazines. The question therefore arises whether this original selection and arrangement is preserved in The Complete National Geographic. In order to answer this question in the affirmative, the *Tasini* court noted that the electronic work "cannot differ in selection by more than a trivial degree from the work that preceded it." *Tasini*, 972 F. Supp. at 823.

As evidence that The Complete National Geographic does not differ by more than a trivial degree from Society's magazines, Defendants have supplied the Court with the declarations of Thomas Stanton, Society's Director of CD-ROM Product Management, who states that: (1) The Complete National Geographic contains an "exact image of each page as it appeared in the Magazine;" (2) The Complete National Geographic draws from the northeastern edition of Society's magazine; (3) the 30 to 40 regional editions of the magazine which Society publishes are identical except for the advertisements; and (4) at the beginning of each CD-ROM in The Complete National Geographic, there is a short display of images from ten different magazine covers, including the January 1962 cover showing the picture taken by Greenberg of a woman scuba diving around a coral reef. Declaration of Thomas Stanton, P 5-7; Reply Declaration of Thomas Stanton, P 4. Greenberg has not adduced any evidence to contradict Stanton's statements.

He submits, however, that the image display and Society logo at the beginning of each disc, the credit display at the end

of each disc, and Society's selection of one edition of the many editions of the magazine, render The Complete National Geographic more than trivially different from Society's magazines. This Court disagrees, and concludes that the evidence produced by Defendants indicates that the Complete National Geographic "retain[s] enough of Defendants' periodicals to be recognizable as versions of those periodicals." *Tasini*, 972 F. Supp. at 824. Consequently, The Complete National Geographic constitutes a 'revision' of Society's magazines within the meaning of 17 U.S.C. § 201(c). Defendants therefore did not improperly reproduce or distribute, in The Complete National Geographic, Greenberg's photographs.

Accordingly, it is hereby ORDERED AND ADJUDGED that:

(1) Defendants' motion to dismiss and/or for summary judgment as to count II, be DENIED;

(2) Defendants' motion for summary judgment as to counts III, IV and V, be GRANTED. Counts III, IV and V are therefore DISMISSED with prejudice.*

(3) Plaintiff Greenberg's cross-motion for summary judgment as to count III, be DENIED;

(4) Plaintiff Greenberg's motion to voluntarily dismiss count IV, be DENIED as MOOT; and

(5) Defendants' request for oral argument, be DENIED.

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* Defendants also contend that counts III through V should be dismissed because their use in the image display at the beginning of each disc of The Complete National Geographic of Greenberg's 1962 cover photograph of a woman scuba diving around a coral reef is: (1) de minimis; and (2) fair use within the meaning of 17 U.S.C. § 107. In light of its conclusion that Defendants are permitted to use the cover photograph at issue pursuant to 17 U.S.C. § 201(c), the Court need not entertain these arguments.

DONE AND ORDERED in Chambers, at Miami, Florida on this 14 day of May, 1998.

/s/
Joan A. Lenard
United States District Judge